

REMARKS

This Amendment is filed in response to the Office Action dated January 25, 2006. Reconsideration of this application is requested in view of the foregoing amendments and the following remarks.

Before this amendment, claims 1-27 were pending. Claims 1-5 were rejected. Claims 3-27 have been cancelled in this amendment and applicants affirm the provisional election without traverse made on January 20, 2006. Claims 1 and 2 are presently pending in this application. Applicants reserve the right to pursue the subject matter of claims 6-27 in a subsequent divisional patent application. The cancellation of claims 6-27 in this application was in response to a restriction requirement issued by the patent office and is not related to patentability. Thus, claims 1-2 are presently pending in the application.

The patent office sets forth that during a telephone conversation with Glenn Smith on 1/20/06 a provisional election was made without traverse to prosecute the invention of Group I, claims 1 to 5. Affirmation of this election is made by applicant in reply to this Office action. Claims 6 to 27 are withdrawn from further consideration by the examiner, 37 CFR 1:142(b), as being drawn to a non-elected invention and therefore cancelled by applicants. The cancellation of claims 6-27 does not change inventorship for this application.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The patent office sets forth that claims 1, 2 and 5 are rejected under 35 U.S.C., 102(b) as being anticipated by O'Lenick, Jr. et al. '625 [stet '652] (herein O'Lenick). O'Lenick teaches silicone alkoxylated esters. See the top of column 4, when "q" is 0 and both R' groups are the formula shown on lines 13 and 14. One specifically taught embodiment for R" is -CH=CH-. Such a copolymers meets that of claim 1 when W is 0 and Y is OH.

Particularly, note Reactant Example VII on column 5; which will result in the terminal groups required by the instant claims (having cis configuration). Note too the silicones on lines 10 to 15 which, when reacted; will have terminal ester groups. The Examiner refers to 5,180,843

(column 3; lines 40 to 60) as showing that the compounds in Examples 9 to 13 do, in fact, correspond to the structure on column 7, lines 10 to 15, wherein "q" is 0.

Thus for the table on column 8; the only difference between examples 23 to 27 is that they contain CH₂-CH₂ R' groups rather than -CH=CH-. However the fact that there is a limited selection for R" groups and that patentee specifically teaches -CH=CH- as a preferred embodiment would lead the skilled artisan to find the claimed polymer fully disclosed and anticipated by the prior art.

On the other hand; the only difference between example 7 and that claimed is the presence of "o" groups in the siloxane backbone. However in view of the fact that siloxanes having no "o" groups are specifically shown and used to prepare the silicones in O'Lenick the skilled artisan would have immediately envisioned the prepolymer of example 7 prepared with a siloxane having no "o" groups and as such this prepolymer is anticipated by the prior art. For claim 2, this limits the number of carbon atoms in R, but since "n" is from 1 to 10 there can be up to 100 carbon atoms in this compound (in addition to Q atoms). Thus the definition of a+b+c meet this limitation. On the other hand note, for instance, the siloxane in example 9 in which a+b+c = 0. This will result in a polymer meeting claim 2.

The amendment of independent claim 1 and the claim that depends therefrom is believed to obviate this rejection.

The office action further sets forth that claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Lenick, Jr. '269 and O'Lenick Jr. 542.

The teachings in these references are comparable to O'Lenick '625 in that they prepare the base polymers in '625 and subsequently react the terminal -OH group. The Examiner relies on the rationale detailed in paragraph 8, supra; for this rejection.

The Examiner has made rejections over these references because they correspond to the claimed prepolymer when Y is a residue having a carboxyl group. See for instance column 3, lines 15 to 50 of '542, which shows a prepolymer having a terminal salicylic acid group. See also column 2; lines 20 to 60, which shows a prepolymer having a terminal lactic acid group.

The amendment of independent claim 1 and the claim that depends therefrom is believed to obviate this rejection.

The office action further sets forth that claims 1 to 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Mueller et al.

Mueller et al. teach polysiloxane hydrogels. Particular attention is drawn to formula (B) having the dimethylsiloxane backbone shown on line 36 of column, 4. Note that R3 can be COOK.

This corresponds to the claimed terminal group when Y is OH. While the formula on column 4 embraces the claimed prepolymer the more specific teachings on column 7 are relied upon as anticipating the claimed prepolymer.

The bottom of column 7 refers to the terminal groups when X represents -C00- or -CONR5-. This corresponds to the -COW- linkage in instant claim 1. The terminal groups are then the "monoacyl radicals of maleic, fumaric or itaconic acid, or the monoalkyl, esters" thereof. These monoacyl radicals correspond to a terminal group having a terminal OH group corresponding to the claimed Y group. The maleic acid will form a cis configuration, the fumaric acid will form a trans configuration while the itaconic acid will result in the compound of claim 4: Since this provides a detailed explanation of terminal groups corresponding to those claimed and since one must select from only 2 different siloxane backbones, one of which meets the siloxane backbone in the claimed prepolymer, the teachings in Mueller et al. anticipate the instant claims.

The amendment of independent claim 1 and the claim that depends therefrom and the cancellation of claims 3-5 are believed to obviate this rejection.

Claims 1 and 2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 5 of copending Application No. 10/875,969. Although the conflicting claims are not identical; they are not patentably distinct from each other because in the prepolymer of '969, when Y is the reactive oligomer derived from a hydroxy reactive monomer, this will correspond to the claimed prepolymer in which Y is a residue having a reactive functional hydroxyl group.

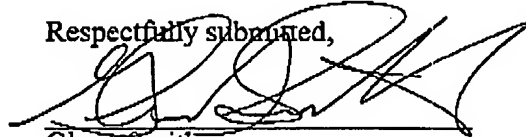
The amendment of independent claim 1 and the claim that depends therefrom and cancellation of claims 3-5 is believed to obviate this rejection.

In view of the foregoing arguments and amendments, Applicants believe that the application is in condition for allowance. An early and favorable action on the merits is solicited.

No additional fee is believed to be due. However, please charge any additional fees or credit overpayment to Deposit Account No. 02-1425.

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